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STORAGE TECHNOLOGY CORPORATION
ONE STORAGE TEK DRIVE, MS-4309
LOUISVILLE CO 80028-4309

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AUG 11 2005

OFFICE OF PETITIONS

In re Application of	:	
Milligan, et al.	:	
Application No.: 10/791,205	:	DECISION REFUSING STATUS
Filed: March 2, 2004	:	UNDER 37 CFR 1.47(a)
Attorney Docket No.: 2003-023-DSK	:	
For: CANISTER-BASED STORAGE SYSTEM	:	

This is a decision on the petition under 37 CFR 1.47(a), filed June 30, 2004(certificate of mailing date June 28, 2004).

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. Any response should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)" and may include an oath or declaration executed by the inventor. **Failure to respond will result in abandonment of the application.**

The above-identified application was filed on March 2, 2004 without an executed oath or declaration. Accordingly, on May 24, 2004, a "Notice to File Missing Parts of Nonprovisional Application" was mailed, requiring, an executed oath or declaration, a surcharge for its late filing, and replacement drawings within an extendable two month period from the mail date of the notice.

In response, on June 30, 2004 (certificate of mailing date June 28, 2004), the surcharge, a declaration executed by ten of eleven joint inventors, authorization to charge the petition fee, and the instant petition were filed.¹ Attorney Timothy R. Schulte argues that non-signing joint inventor Jacques Debiez has constructively refused to join in the filing of the above-identified application.

¹Regarding finances, deposit account no. 19-4545 will be charged the required \$130.00 Rule 47 petition fee, which is the fee that was due on June 30, 2004, when the Rule 47 petition was filed. In addition, the same deposit account will be charged a two month extension of time fee of \$420.00. This is the fee that was due on September 17, 2004, when applicants submitted replacement drawings in response to the May 24, 2004 Notice.

A grantable petition under 37 CFR 1.47(a) requires

- (1) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (2) a proper oath or Declaration executed by the available joint inventor(s),
- (3) the fee of \$130.00
- (4) the last known address of the omitted inventor(s).

This petition lacks item (1) above.

As to item (1), Applicants have failed to establish that the inventor has refused to sign the declaration. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. **The Office requires that the non-signing inventor be provided with a complete copy of the application as filed.** This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d).

In the June 11, 2004 e-mail from Inventor Debiez to Ms. Stephanie Klepp, Inventor Debiez alleges "misappropriation made visible" and states that he and his attorney will carefully check any further applications that his former employer, StorageTek, files on topics he worked on and will notify authorized agencies with any discrepancies. He states that there will be lawsuit consequences for StorageTek about any submission related to the canister concept or anything he was involved in as a principal inventor. He states it would have been easier to keep him updated and to find an agreement.

The fact that Inventor Debiez threatens lawsuits does not absolve StorageTek of providing him with a copy of the application as filed and a declaration for patent application. As a named inventor, he will be entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or make his position of record in the application.

Inventor Debiez must have the complete application in his possession in order to make an informed decision as to whether he joins in its filing. When petitioners can show that Inventor Debiez was mailed or recieved the complete application and that he either refused to sign the declaration or would not respond to the request that he sign the declaration, petitioners will have satisfied this requirement.

In addition, the undersigned would like a copy of the letter (translated if necessary) referenced in the May 22, 2003 e-mail from Florence Melou to Dale L. Boland, written by Inventor Debiez and addressed to STK HQ legal department, that states Inventor Debiez will take them to court if he receives a patent correspondence at his private address.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450

By hand: U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Petition
Randolph Building
401 Dulany Street
Alexandria, VA 22314

By FAX: (571) 273-8300 - ATTN: Office of Petitions

Telephone inquiries should be directed to the undersigned at (571) 272-3230.



E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy